

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BENJAMIN W. SLIVKA and JEFFREY S. WEBBER

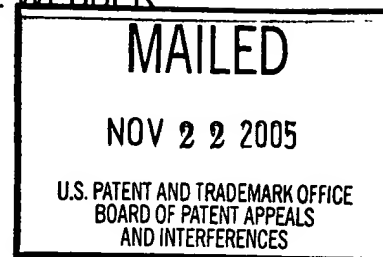
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Appeal No. 2005-2076  
Application No. 09/898,702

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HEARD: October 19, 2005

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Before DIXON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 28-35 and 37-56, which are all the claims remaining in the application.

We reverse.

### BACKGROUND

The invention relates to distributing software over a network using a distribution file that may contain the software to be installed and an installation program for installing the software. Representative claim 39 is reproduced below.

39. A method of building a file for installing software at a remote computer, the method comprising:

placing the software in the file; and

placing, at a location within the file so as to be automatically executed responsive to execution of the file, instructions for installing the software on the remote computer.

The examiner relies on the following reference:

Fawcett	5,845,077	Dec. 1, 1998
		(filed Nov. 27, 1995)

Claims 28-35 and 37-56 stand rejected under 35 U.S.C. § 102 as being anticipated by Fawcett.

We refer to the Final Rejection (mailed Jun. 25, 2003) and the Examiner's Answer (mailed Dec. 17, 2004) for a statement of the examiner's position and to the Brief (filed May 3, 2004) and the Reply Brief (filed Feb. 22, 2005) for appellants' position with respect to the claims which stand rejected.

### OPINION

Appellants argue (Brief at 6) that Fawcett does not describe a single file that contains installable software, an installation application, and installation application

starting instructions. The examiner responds by pointing to material in columns 8 and 9 of Fawcett. According to the examiner, Fawcett teaches “a self-extracting packet (file) having both the software to be loaded and also, within the downloaded packet, the installation routines used to automatically install the software once ‘launched’ by the user . . . .” (Answer at 4.) Appellants respond, in turn, that Fawcett does not mention a “packet” or a “self-extracting file,” and the reference does not describe a file having both software to be loaded and installation routines to automatically install the software. (Reply Brief at 8.)

Fawcett describes different ways of obtaining software from a remote server. As taught at column 8, lines 40 through 63, in the case that the user chooses immediate installation, the update server computer downloads the available software to the user computer and installs the software in the proper directory or subdirectory. The update computer may also reconnect later to complete the downloading and installation.

With delayed downloading (Fig. 5), the software to be transferred is stored on the user computer. Included with the downloaded software is an installation application that the user will use to later install the software. When the user is ready to install the software, the user simply launches the installation application supplied by the update server computer. Fawcett col. 9, ll. 46-62.

We agree with appellants that the examiner has not shown where Fawcett discloses a file having software to be installed and an application for installing the software that is contained within the file. Fawcett does not expressly set forth that the

software and installation application (Fig. 5, box 106) are contained within a single "self-extracting" packet (or file). Nor has the examiner provided evidence that transferring software and an accompanying installation application required that the components be contained within a single file. When a reference is silent about an asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). However, to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

On this record, Fawcett does not meet the requirements of representative claim 39, as set forth supra. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

The examiner has further failed to supply a reference showing some teaching, suggestion, or motivation from the prior art to modify the teachings of Fawcett in accord with the requirements of the instant claims. Such consideration of the prior art would require a determination of what the artisan knew at the time of invention -- i.e., an inquiry into obviousness under 35 U.S.C. § 103. While production and use of a self-

extracting file within the scope of instant claim 39 might be well known and widely used *at present*, consideration of relevant teachings would be limited, in an inquiry under § 103, to those known to the artisan *at the time of invention*.<sup>1</sup> In any event, all of the instant claims are rejected for alleged anticipation by Fawcett, rather than for obviousness.

The remainder of the independent claims contain requirements similar to those in claim 39 that we have discussed. The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Since evidence in support of the rejection is lacking, we cannot sustain the rejection of claims 28-35 and 37-56 under 35 U.S.C. § 102 as being anticipated by Fawcett.


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<sup>1</sup> According to the first page of the instant specification, appellants claim priority (35 U.S.C. § 120) to an application filed April 18, 1996.


## CONCLUSION

**The rejection of claims 28-35 and 37-56 under 35 U.S.C. § 102 is reversed.**

REVERSED

  
JOSEPH L. DIXON  
Administrative Patent Judge

  
ANITA PELLMAN GROSS  
Administrative Patent Judge

  
HOWARD B. BLANKENSHIP  
Administrative Patent Judge

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